

REMARKS

The Office Action of April 6, 2007 has been reviewed and the comments therein were carefully considered. Claims 1-4, 7-12, 14-20 and 22-42 are currently pending. Claims 1-4, 7-12, 14-20 and 22-42 stand rejected.

Claim Rejections Under 35 USC §112

Claims 1-4, 7-12, 14-20, 22-42 were rejected under 35 USC §112, first paragraph, as failing to comply with the written description requirement. By this response, independent claim 1 has been amended to delete "the adhesive element" from the steps of shaping, so that just the second textile element and third textile element are recited to be shaped to have substantially similar dimensions. As the adhesive element is not recited to have substantially similar dimensions as the second and third textile elements, it is not contradictory for the "first bond between the third textile element and the adhesive element to define a bonded area and an unbonded area on a first side of the third textile element" as recited in amended claim 1.

Independent claim 16 has been amended to clarify that the first textile element and the adhesive element have substantially similar outer perimeters while the second textile element has a greater outer perimeter than either of the first textile element or the adhesive element. Therefore, it is possible for the first bond between the adhesive element and the second textile element to be located in a spaced relationship with at least some of outer edges of the second textile element.

Regarding independent claims 24 and 34, paragraph [0043] of the specification as originally filed has been amended, as requested by the Examiner, to describe the adhesive element 40d and how the second textile element is bonded only at the outer perimeter to the first textile element, as illustrated in FIGS. 13-15. The description is supported at least by FIGS. 13-15 of the application as originally filed and no new matter has been added.

As a result, the 35 USC §112, first paragraph, objections to claims 1-4, 7-12, 14-20 and 22-42 are respectfully requested to be withdrawn.

Claims 1-4, 7-12, 14-20 and 22-23 were rejected under 35 USC §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter

which applicant regards as the invention. Claim 1 has been amended to clarify that the first textile element is shaped to have a greater area than the second textile element OR the third textile element. Similarly, claim 16 has been amended to clarify that the second textile element has a greater outer perimeter than either of the first textile element or the adhesive element. Consequently, the Applicant respectfully requests reconsideration and withdrawal of the 35 USC §112 objection to claims 1-4, 7-12, 14-20 and 22-23.

Claim Rejections Under 35 USC §102

Claims 1-4, 8, 10-14, 16-19 and 21-22 are rejected under 35 USC §102(b) as being anticipated by Stahl, U.S. Patent No. 5,422,173 (“Stahl”). Stahl is directed to a method of producing a multi-colored emblem with an embroidered appearance, the emblem being heat sealable onto difficult-to-adhere fabrics. *See Abstract.* Initially, a first textile element 22 and an adhesive element 24 are joined. More particularly, Stahl states that first textile element 22 is laminated on one side with an adhesive element 24 of a thermoplastic material. The combination of first textile element 22 and adhesive element 24 is then cut to the configuration of a letter such as A or any other symbol in a die 36, as shown in Figure 4 (see Stahl, column 3, lines 31-43). As depicted in Figures 2 and 4, this procedure forms first textile element 22 and adhesive element 24 to have substantially identical dimensions. Once first textile element 22 and adhesive element 24 are joined and cut, “the letter blank is sewn, as illustrated in FIG. 5, with a thread 38 about its peripheral edges to produce an embroidered appearance” (Stahl, column 3, lines 44-46).

A similar process is then performed for second textile element 26 and an adhesive element 24’. That is, second textile element 26 and adhesive element 24’ are joined, cut to substantially identical dimensions (see Figures 2 and 6), and “then stitched around its peripheral edges with a thread 42 as shown in FIG. 7 to produce an embroidered appearance” (Stahl, column 3, lines 54-56).

Once each element is joined, cut, and stitched, first textile element 22 is joined to second textile element 24 with adhesive element 24, as depicted in Figure 8. Another adhesive layer 28, which is ultimately utilized to secure the emblem to apparel, is then secured to adhesive layer 24’, as depicted in Figure 9.

In contrast, the method of joining a plurality of textile elements, as recited in amended independent claim 1, recites, among other steps, “shaping the second textile element and the third textile element to have substantially similar dimensions” and “shaping the first textile element to have a greater area than the second textile element or the third textile element.” Similarly, the method of joining a plurality of textile elements, as recited in amended independent claim 16, recites, among other steps, “the first textile element and the adhesive element have substantially similar outer perimeters, the second textile element having a greater outer perimeter than either of the first textile element or the adhesive element.”

With respect to independent claim 1, the Office Action equates items 22 and 26 of Stahl with the second and third textile elements. However, in Stahl the second textile element 22 has lesser area than the third textile element and the adhesive element. That is, Stahl teaches forming second textile element 22 to be smaller than third textile element. Accordingly, Stahl does not teach or suggest the relative dimensions between textile elements recited by independent claim 1. Therefore, for at least these reasons Applicant respectfully submits that independent claim 1 is allowable over Stahl. Dependent claims 2-4, 7-12, and 15 are allowable for at least the same reasons as independent claim 1 from which they ultimately depend.

With respect to independent claim 16, the Office Action equates item 26 to be the first textile element and item 22 to be the second textile element. However, due to the Office Action’s construction (first textile element 26 and second textile element 22), Applicants claimed feature of “forming a first bond between the second textile element and the adhesive element through the application of heat and pressure to define a bonded area and an unbonded area on a first side of the second textile element, the first bond being located on the first side of the second textile element and in a spaced relationship with at least some of outer edges of the second textile element” is not met.

The step of forming a bond that includes a bonded area and an unbonded area on a first side of the second textile element is not shown or taught by Stahl. Indeed, Stahl teaches away from the methods of claims 1 and 16 in that Stahl teaches applying an adhesive layer 24 and 28 across the entirety of the blanks 22 and 26, respectively, and therefore does not teach a bonded and unbonded area on a side of a textile element. *See* Col 3, lines 15-22; Col. 4, lines 4-13; Figs. 2, 8, 9 and 11. Therefore, for at least this reason Applicant respectfully submits that independent

claim 16 is in condition for allowance. Dependent claims 17-20 and 22-23 are allowable for at least the same reason as independent claim 16 from which they ultimately depend.

Similarly, independent claim 24 is not anticipated by Stahl. Claim 24 recites, among other features, an article including “a second textile element defining an outer perimeter, the second textile element extending over the first textile element and bonded only at the outer perimeter to the first textile element.” Stahl simply does not teach the technique of seam bonding discussed in the specification and recited by claim 24. Rather, as discussed above, Stahl teaches applying an adhesive layer across the entirety of the blanks to join the blanks together in a stacked manner, that is, one blank on top of the other. For these reasons, Stahl does not anticipate claim 24. Moreover, dependent claims 25-33 are also allowable for at least the same reasons as independent claim 16 from which they ultimately depend.

Claim Rejections Under 35 USC §103

Claims 7, 15 and 20 are rejected under 35 USC §103(a) as being unpatentable over Stahl in view of Mahn, Sr., et al., U.S. Patent No. 4,971,644 (“Mahn”). Claims 9 and 23 are rejected under 35 USC §103(a) as being unpatentable over Stahl in view of either Conrad, U.S. Patent No. 3,662,878 (“Conrad”) or Castro, Jr., U.S. Patent No. 5,906,006 (“Castro”).

For the same reasons expressed above, Mahn, Conrad or Castro does not render obvious the pending application because these references do not obviate the noted deficiencies in Stahl. Mahn discloses a method of applying a heat activated transfer to a substrate. *See* Col. 2, line 45. The heat activated transfer includes an upper bearing layer and a lower heat activated adhesive layer. This is applied to a cloth. Col. 2, line 46-49. Mahn does not teach or suggest forming a bond that has a bonded area and an unbonded area on a side of a textile element, nor does Mahn teach the technique of forming a bond only at an outer perimeter on the same textile element. Consequently, Mahn does not render obvious the pending claims.

Moreover, Conrad or Castro does not render obvious the pending application because Conrad teaches the use of an “interposed layer of thermoplastic or glue” which extends across the entirety of a patch that is to be attached to a garment. *See* Col. 1, lines 23-26. Likewise, Castro teaches attaching a logo or emblem across headwear by adhesives, presumably applied across the entirety of the logo.

For the foregoing reasons, the Applicant respectfully submits that claims 7, 9, 15, 20, 23, 26, 30-32, 34-37 and 42 are allowable over Stahl in view of Mahn, Conrad or Castro.

All rejections and objections having been addressed, the Applicant respectfully submits that the instant application is in condition for allowance, and respectfully solicits prompt notification of the same.

Respectfully submitted,

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